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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,156	11/15/2001	Avi J. Ashkenazi	P2730P1C28	5501
35489	7590	09/15/2004	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 275 MIDDLEFIELD ROAD MENLO PARK, CO 94025-3506			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/998,156

Applicant(s)

ASHKENAZI ET AL.

Examiner

Robert Landsman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 119-121 and 123 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 119-121 and 123 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/10/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***1. Formal Matters***

- A. The Amendment dated 8/10/04 has been entered into the record.
- B. Claims 119-124 were pending in this application. In the Amendment dated 8/10/04, Applicants canceled claims 122 and 124. Therefore, claims 119-121 and 123 are pending and are the subject of this Office Action.
- C. The Information Disclosure Statement dated 8/10/04 has been entered into the record. All references have been considered.
- D. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

### ***2. Priority***

- A. After review of Applicants' arguments as well as the specification, the Examiner agrees that the chondrocyte proliferation assay is specific, substantial and well-established utility. Therefore, the present invention possesses utility under 35 USC 101 and is enabled under 35 USC 112, first paragraph. Therefore, the present invention receives priority to PCT/US00/08439, filed March 30, 2000.

### ***3. Specification***

- A. Though no objection was made to the specification regarding hyperlinks, it is noted that Applicants have amended the specification to remove any hyperlinks.
- B. The objection to the specification regarding the title has been withdrawn in view of Applicants' amendment to the title to recite "PRO844 Antibodies."

### ***4. Claim Objections***

- A. The objection to claims 119-121 and 123 has been withdrawn in view of Applicants' amendment to claim 119 to replace the phrase "as shown in Figure 240 (SEQ ID NO:345)" with "of SEQ ID NO:345."

**5. Claim Rejections - 35 USC § 112, second paragraph**

A. The rejection of claim 122 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' cancellation of this claim and the incorporation of the term "fragment" into claim 119. As written in claim 119, the term "fragment" no longer raises issues under 35 USC 112, second paragraph.

B. The rejection of claim 124 under 35 USC 112, second paragraph, regarding "specifically binds" has been withdrawn in view of Applicants' cancellation of this claim. Therefore, the claims no longer recite both "binds" and "specifically binds." No rejection is being made regarding the term "specifically binds" in claim 119 since this term has a well-established meaning in the art.

**6. Claim Rejections - 35 USC § 102**

A. Claim 119 remains rejected under 35 USC 102 for the reasons already of record on pages 3-4 of the Office Action mailed 5/10/04. Applicants have amended claim 119 to recite "specifically binds" and argue that the term "specifically binds" has a well established meaning, and is understood by those skilled in the art to mean that the antibody binds to a particular polypeptide, and does not significantly bind to another polypeptide. These arguments have been considered, but are not deemed persuasive. It is well-known in the art that antibodies do not bind to only one peptide. Antibodies are selective for antigens in those peptides and would be expected to bind any peptide comprising that antigen. The protein of Ni et al. is 66.5% identical and shares a 75 amino acid overlap with the protein of SEQ ID NO:345 of the invention. Therefore, given the art-accepted definition of "specifically binds" as well as the well-known properties of antigen-antibody binding, it would be expected, in absence of evidence to the contrary, that antibodies which bind to the protein of Ni et al. would also bind to the protein of the present invention (SEQ ID NO:345).

In further support of his position, the Examiner cites Elgert (Immunology :Understanding the Immune System, page 416, 1996). Elgert defines specific binding as "selective reactions occurring between an antigen and its corresponding antibody-combining site." This definition does not state that an antibody will bind only one protein (i.e. exclusive), but that the antibody will react with its corresponding antigen. Therefore, an antibody would be expected to bind any peptide comprising that antigen. This reference is not being used as a grounds of new rejection, but simply to rebut Applicants' arguments.

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**7. Claim Rejections - 35 USC § 103**

A. Claims 119-121 and 123 remain rejected under 35 USC 102 for the reasons already of record on page 4 of the Office Action mailed 5/10/04. In this rejection, the Examiner inadvertently stated that "the teachings of Goldberg are recited in the above rejection under 35 USC 102." It is clear, however, that the Examiner intended to recite that these were the teachings of Ni et al. It appears that Applicants understood this point as no argument was made to the contrary. As discussed in the above rejection under 35 USC 102, Applicants argue that Ni et al. do not teach the antibodies encompassed by the present invention, nor does Goldberg anticipate antibodies that specifically bind SEQ ID NO:345. These arguments have been considered, but are not deemed persuasive for the reasons discussed above in the rejection under 35 USC 102.

**8. Conclusion**

A. No claim is allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Advisory information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D.  
Patent Examiner  
Group 1600  
September 09, 2004

  
**ROBERT LANDSMAN**  
**PATENT EXAMINER**